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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/598,751	09/11/2006	Michael John Hancock	HPJ0103PUSA	9823
22045	7590	08/13/2009		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER KATCHEVES, BASIL S	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 08/13/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/598,751	Applicant(s) HANCOCK, MICHAEL JOHN	
	Examiner BASIL KATCHEVES	Art Unit 3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/8/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The applicant has submitted a preliminary amendment, dated 9/11/06 which states that it replaces "all prior version" of claims. In this set, claims have been amended and claims 16-17 have been cancelled. Originally presented claims, 9/11/06, are 1-25. Thus 18-25 have not been identified in the preliminary amendment and is unclear. Additionally, the claim fee sheet of 5/7/07 also indicates only 17 claims are pending. The following 17 claims, (16 and 17 are cancelled, leaving 1-15 pending) are examined below.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No.

Art Unit: 3635

10/598748 (PUB 2007/0193191) Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 is substantially similar to claim 1 of '748 for claiming a fixed and moving panes and the fixed pane (locked) is covered by cladding (in recess).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-5 and 7-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,551,196 to Paredes et al.

Regarding claim 1, Paredes discloses a joinery assembly having a fixed panel (fig. 2: 10), covered by cladding (30) and a sliding panel (fig. 3: 20) and covered by cladding of the exterior section.

Regarding claim 2, Paredes discloses the panels as double sheets of glass (13 & 23).

Regarding claim 3, Paredes discloses the use of aluminum (column 1, lines 28-29).

Art Unit: 3635

Regarding claim 4, Paredes discloses the assembly as having surfaces exposed to the interior.

Regarding claim 5, Paredes discloses the cladding as having an inherently insulative material as cladding (aluminum or PVC, 54, 74).

Regarding claim 7, Paredes discloses the panels as aligned (fig. 3: 10 & 20).

Regarding claim 8, Paredes discloses a glazing spacer (fig. 3: 28 & 18) in both the fixed and sliding panels and the spacers are aligned (meeting across a common plane).

Regarding claim 9, 12, Paredes discloses the interior of the sliding panel (fig. 3: 20) as covered by the cladding (72, 71) of the exterior (10) panel.

Regarding claims 10, 11, Paredes discloses the interior surface edges of a frame (25) on the sliding panel as being covered by the cladding (72, 71).

Regarding claim 13, Paredes discloses the sliding panel form defines a track (area which the form slides along) which runs along the length of the fixed panel and parallel to the fixed panel.

Regarding claim 14, Paredes discloses the sliding panel as bottom rolling (see roller 25a) at bottom.

Regarding claim 15, Paredes discloses the rolling panel as having a removable connection to a carriage (73; or inherently removable to bottom portion, fig. 3: with parallel legs securing the roller).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 5,551,196 to Paredes et al.

Regarding claim 6, Paredes teaches that wood windows have been used for hundreds of years (column 3, lines 1-2) but states that wood is not as desirable as aluminum for thermal efficiency. Even though, It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Paredes by using portions of wood for cladding, since wood has been standard for many years in the art of windows, in areas where thermal insulation is not as relatively important, such as areas of mild weather. The use of portions of wood cladding would be an aesthetic decision based upon matching with the surrounding area of the structure as an example, with wood walls, floors, exterior siding, etc. The applicant should also note that wood is a functional equivalent of aluminum in the windows art and is currently in use on many windows.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited patents listed on the included form PTO-892 further show the state of the art with respect to window frames in general.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Basil Katcheves whose telephone number is (571) 272-6846. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot, can be reached at (571) 272-6777.

/Basil Katcheves/

Primary Examiner, Art Unit 3635